

91-588

Supreme Court, U.S.  
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**In the Supreme Court**  
OF THE  
**United States**

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OCTOBER TERM, 1991

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ANDERS E. TRELL,  
*Petitioner,*

v.

SENTEX SYSTEMS, INC., and  
WILLIAM R. DAVIS,  
*Respondents.*

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**PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT**

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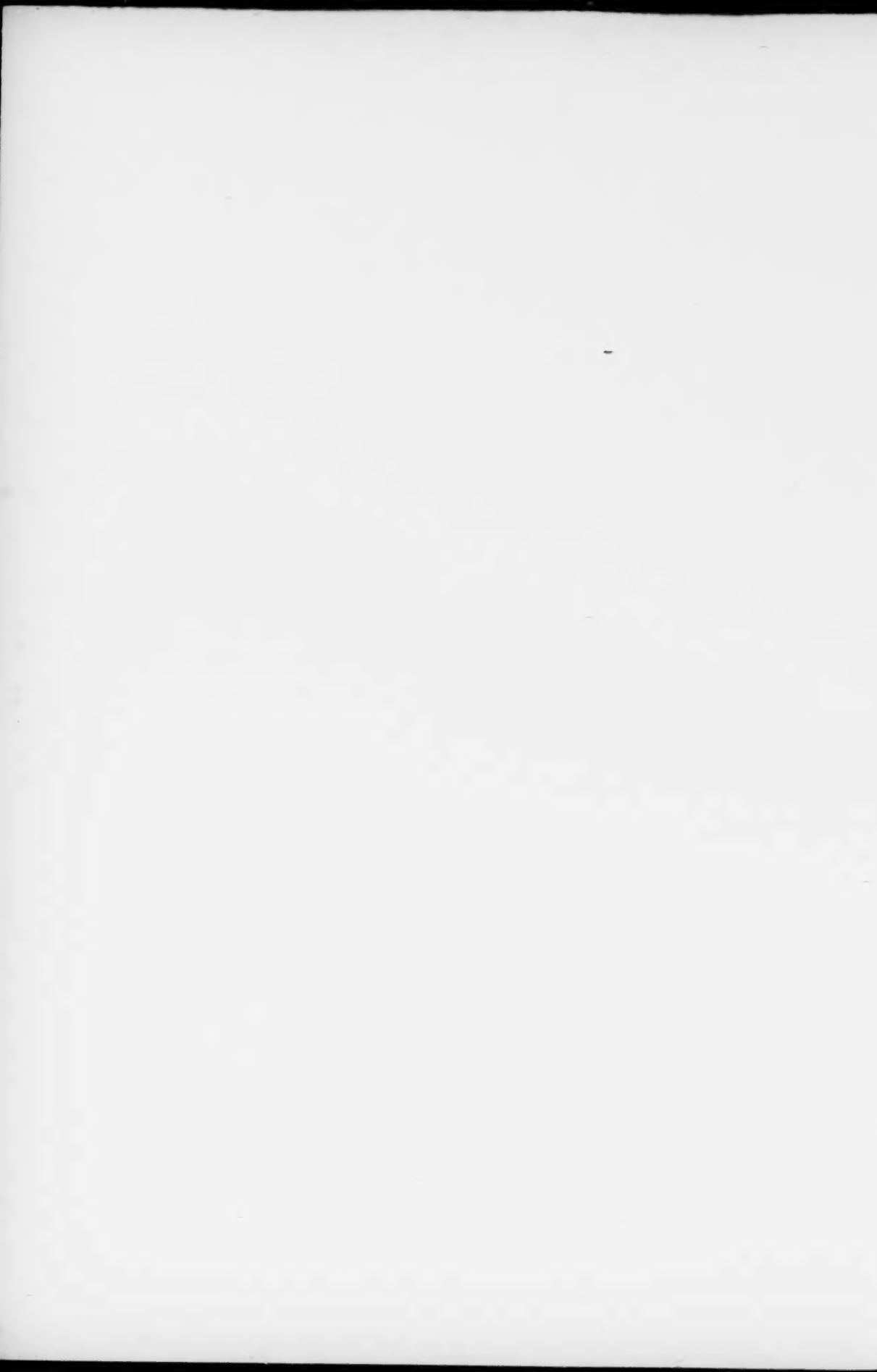
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## QUESTIONS PRESENTED FOR REVIEW

The United States Court of Appeals For The Federal Circuit has sanctioned (by affirming without opinion pursuant to Fed.Cir.R. 36) a summary judgment of patent claim invalidity by the United States District Court for the Central District Of California, which summary judgment proceedings so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

The specific questions presented for review are:

1. Whether it was improper for the district court to conduct a trial of the issue of patent claim validity on declarations under the guise of deciding a motion for summary judgment, by making credibility determinations, weighing the evidence, and adjudging that claims 4 and 9 are invalid.
2. Whether summary judgment that claims 4 and 9 are invalid was improper because Respondents failed to carry their burden of showing that there is no genuine issue as to any material fact.
3. Whether it was improper for the district court to adjudicate the validity of independent patent claim 4 as to which there was no actual controversy under 28 U.S.C. § 2201, for the purpose of facilitating its determination of invalidity of dependent claim 9.

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## JURISDICTION

The Judgment of the United States Court of Appeals for the Federal Circuit (Appeal No. 91-1068) affirming the Judgment of the United States District Court for the Central District of California (Case No. CV 89-3355) pursuant to Fed. Cir. R. 36 (without opinion), was Entered on June 7, 1991.

A timely filed Petition for Rehearing was denied on July 9, 1991.

This Court has jurisdiction under 28 U.S.C. § 1254(1).

## STATUTES INVOLVED

35 U.S.C. § 102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless —

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . .

35 U.S.C. § 103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

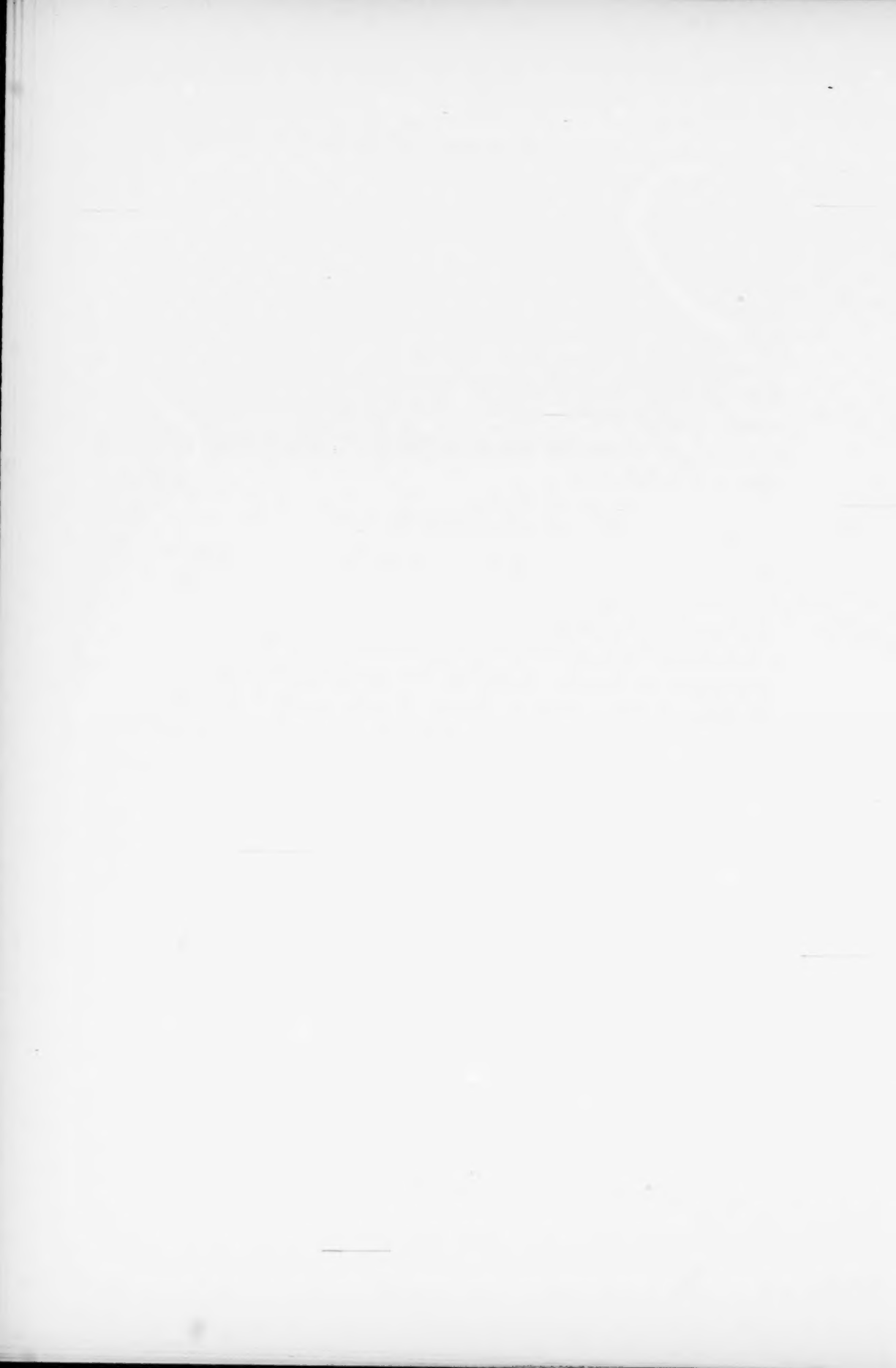
Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 282. *Presumption of validity; defense*

A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.

28 U.S.C. § 2201. *Creation of remedy*

(a) In a case of actual controversy within its jurisdiction, . . . any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought. Any such declaration shall have the force and effect of a final judgment or decree and shall be reviewable as such.



## STATEMENT OF THE CASE

United States Letters Patent 3,947,641 issued to Petitioner on March 30, 1976, based upon an application filed June 3, 1974. Petitioner claimed the benefit of the filing date of June 7, 1973 of Swedish patent application No. 7308086. The District Court deemed Petitioner's invention date to be his Swedish filing date of June 7, 1973.

Claims 4 and 9 of the suit patent, which are the claims in issue, read as follows:

4. In combination with a public automatic subscriber telephone network an apparatus having connecting means by which the apparatus can be connected to a door lock, comprising:

switching means by which said apparatus can be coupled onto a telephone line going out to the automatic exchanges of said telephone network;

selecting means for dialing telephone numbers to said telephone network;

discriminating means for securing that only certain telephone numbers out of all those of the whole said telephone network can be selected resulting in said telephone networks performing a call to one of said telephone networks subscriber telephone sets;

means for verbal communication with said subscriber telephone; and

means responsive to signals induced from said subscriber telephone for thereupon releasing said door lock.

9. The combination of claim 4, wherein said selecting means also addresses a common combination lock device.

## **Description Of The Apparatus Of Claims 4 And 9**

The subject matter of these claims is a telephone entry control system which is used in combination with a public automatic telephone network, for controlling access to a locked building containing a locked door and also containing telephones which are connected to the public telephone network, such as an apartment building.

Claim 4 covers what can be referred to as one form of the basic apparatus. Described in general terms (with claim language being shown within quotation marks), the system includes an entrance telephone set outside the building, which set is "coupled" onto a telephone line going to the automatic exchanges of said telephone network, and which includes "selecting means for dialing telephone numbers to said telephone network."

A visitor desiring to gain access to the building consults a tenant's directory and locates the short number which has been assigned to the tenant he desires to contact. The visitor then dials the short number on the entrance set using the aforesaid "selecting means".

The apparatus also contains "discriminating means for securing that only certain telephone numbers out of all those of the whole said telephone network can be selected resulting in said telephone networks performing a call to one of said telephone networks subscriber telephone sets". Thus, the apparatus examines the number which has been dialed, and if it corresponds to a programmed number which has been assigned to a tenant, the apparatus automatically dials the tenant's actual telephone number to the central office through the public telephone network, which causes the tenant's telephone to ring.

The apparatus further contains "means for verbal communication with said subscriber telephone". Thus, the visitor and the tenant can converse in a normal manner.

Lastly, the apparatus includes "means responsive to signals induced from said subscriber telephone for there-



upon releasing said door lock." Thus, if the tenant wishes to permit the visitor to enter the building, the tenant depresses, for example, the number 9 button on his telephone, which produces a signal which returns to the apparatus via the public telephone network, thereupon actuating a door strike which releases the door lock and permits the visitor to enter the building.

Claim 9, which is independent from claim 4, includes all of the limitations or features of claim 4, plus what has been referred to in the case as the direct access feature.

In practice, each tenant chooses or is assigned a secret or personal number different from the directory number, which the tenant can use for gaining access to the building using the same "selecting means" at the entrance set to dial the secret or personal number, which "addresses a common combination lock device" in the apparatus to actuate the door strike and release the door lock. Thus, when a number is dialed at the entrance set using the "selecting means", it is checked at the "discriminating means" and if it is recognized as a tenant's number, it is routed through the public telephone network to the tenant's telephone, as previously described. On the other hand, if it is recognized as a tenant's secret or personal number, it is routed directly to the "common combination lock device" without going through the public telephone network.

### Pleadings

On March 7, 1989, Petitioner's attorney sent a letter to Respondent Sentex, advising it of the recent decision of the Court of Appeals in the Marlee case; stating that Sentex's entry control systems appear to infringe claim 9 of patent 3,946,641; and offering Sentex a non-exclusive license at a royalty rate of six (6) percent of the wholesale selling price of the equipment.

On June 1, 1989, Petitioner filed a Complaint For Patent Infringement against the Respondents in the United States District Court for the Central District of California, alleg-

ing that each of them has knowingly and willfully been a direct infringer, a contributory infringer, and/or has induced the infringement of claim 9 of patent 3,947,641 (Case No. CV 89-3355). The basis for federal jurisdiction of the United States District Court is 28 U.S.C. § 1338(a). The case was transferred to Judge Tevrizian under the "low number rule" of the Central Judicial District of California.

On August 21, 1989, Respondents filed their Answer And Counterclaim, denying the validity and infringement of patent 3,947,641, and, in a Counterclaim For Declaratory Judgment, alleged there was an actual controversy as to the validity and infringement of patent 3,947,641, and prayed that the Court enter a Judgment that said patent and each and every claim thereof is invalid.

Petitioner's Answer To Counterclaim For Declaratory Judgment denied there was an actual controversy as to any claim other than claim 9.

In an Order for Court Trial, the District Court stated that no motions for Summary Judgment or Partial Summary Judgment may be filed later than fifteen (15) days after the discovery cut-off date. In a separate order, the discovery cut-off date was stated to be April 30, 1990.

On May 7, 1990, Respondents filed a Motion For Summary Judgment Of Invalidity Of Patent Claims 4 And 9. At a hearing on May 29, 1990, the District Court orally denied Respondents' Motion For Summary Judgment, without prejudice.

Respondents filed a Renewed Motion For Summary Judgment Of Invalidity Of Claims 4 And 9 on June 18, 1990, more than fifteen (15) days after the discovery cut-off date. The discovery cut-off date had not been extended.

Oral argument on Respondents' Renewed Motion For Summary Judgment was ultimately scheduled for 10:00 a.m. on August 20, 1990.

At approximately 1:30 p.m. on August 20, 1990, prior to the oral hearing in the matter, counsel for the parties were handed copies of the District Court's "Memorandum Of Decision And Order", granting Respondents' Motion For Summary Judgment Of Invalidity Of Claims 4 And 9. The document had already been signed by the District Court and marked "Filed" that same date (P.A. 1a-20a).\*

### **Summaries Of The Declarations Filed In Support Of Respondents' Renewed Motion For Summary Judgment.**

1. Hector Ruiz, the owner of a private telephone equipment company in Pasadena, stated that:

When he commenced work with Pacific Telephone in 1969, he was based at the facility located at 921 East Compton Street. That facility, as well as other Pacific Telephone facilities he visited, had an entry control system at its entrance to open the normally locked door at the entrance. The system included a standard telephone instrument on the wall at the entrance. He and other employees at the facility were provided with the same number which they were to dial into the entrance telephone via its rotary dial in order to gain access to the building. When this number was dialed, the door unlocked directly, permitting the employee to enter the building.

A set of instructions posted near the telephone advised non-employees to dial a number which was different from the employees number in order to gain entrance to the building. The telephone instrument at the entrance was connected to selected employee telephones via a local switching device and a dedicated line. The dialing of the non-employee telephone number would cause one of the dedicated line-selecting buttons to flash, and the dialed employee's telephone to ring. The employee would push the dedicated line selecting button, and lift the handset to

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\* The letters "P.A." refer to Petitioner's Appendix attached hereto.

establish voice contact with the person at the entrance. If the person's entry was desired, the employee would dial a number which, instead of ringing a telephone, activated the striker at the entrance.

Attached as Exhibit 1 to Mr. Ruiz's declaration, is a photocopy of a page from a ring binder, containing the words ENTRY CONTROL SERVICE at the top and a listing of the installation charge and the monthly rate for various types of equipment which were not specifically described.

Mr. Ruiz did not produce any drawings or schematic wiring diagrams showing the electrical circuits to which he referred.

2. Robert Margolis, a businessman and co-founder of Marlee Electronics Corporation, stated that:

Instrumentation Technology Corporation (ITC), delivered a prototype unit to Marlee on or about March 5, 1973.

On April 2-4, 1973, Marlee demonstrated the Entraguard prototype unit at the "Apartment Builder/Developer Conference And Exposition" in Miami, Florida.

The prototype was mounted to a panel in the booth, and a hinged door with an electric door strike was mounted to another panel. They had ordered two telephone lines installed at the booth, and one standard telephone. The telephone was connected to one of the telephone lines, and was placed on a coffee table to represent a tenant's telephone. The second telephone line was connected to the prototype unit. To demonstrate the Entraguard system, visitors were encouraged to dial a three digit code into the prototype unit, which code the person selected from a model directory. *The prototype unit had been programmed to dial the telephone number of the tenant's telephone on the coffee table, regardless of which code was selected.* When the tenant's telephone rang, a different person would pick up the telephone, converse with the first person, and then dial "9", which would cause the prototype unit to activate the door

strike, permitting the door to be opened (Emphasis added.).

3. John A. Ahlstrom, an employee of Respondent Sentex, who was formerly employed at Instrumentation Technology Corporation and who did the conceptional design work on what was later designated as the Entraguard system, stated that:

In the Spring of 1973, prior to the month of June, he attended a trade show in Miami, Florida at which Marlee introduced the Entraguard. He was at the show for 3 or 4 days to answer technical questions and to solve any technical problem which might arise. Marlee had rented booth space at the show, and demonstrated the prototype made by ITC. The prototype was connected to the Miami public telephone system. A simulated building directory was placed adjacent to the connected prototype, and a second telephone line was connected to an ordinary telephone in the booth, which represented a tenant's telephone.

The Entraguard unit was programmed to dial the telephone number of the "tenant" telephone via the Miami public telephone network *regardless of which code number was selected from the directory* (Emphasis added.).

In 1966, he had seen a direct access system which used key-pad entry at Computer Measurement Company ("CMC"), a former employer. The system used by CMC employed a ten-key set of numbered buttons adjacent to a normally locked entranceway. If one entered the proper sequence of numbers, the entranceway door strike was activated, and the door could be opened.

The addition of a direct access feature to the Entraguard unit, by which the entrance door could be unlocked without involving the public telephone network via entry of an access code into the Entraguard keypad, would have been an obvious and trivial modification in late 1972 and early 1973.

Furthermore, the addition of a direct access feature using the Entraguard's telephone keypad would have been obvious to any circuit designer of ordinary skill in view of that same combination of telephone entry and direct access in the Pacific Telephone system described in the declaration and deposition transcript of Hector Ruiz, both of which he had reviewed.

4. Don Janess, President of Instrumentation Technology Systems . . . who was represented by Respondents' attorney in discovery matters in the case at bench, stated that:

In late 1972, while at ITC he was assigned to design and develop an entry control system for one of ITC's customers, namely Marlee Electronics, which was eventually called the Marlee Entraguard, and he eventually built a working prototype. During the course of the development program, he was responsible for the detailed circuit design, and personally designed most of the system's circuitry. During the project, he reported to John Ahlstrom, ITC's vice president and director of engineering.

He reviewed U.S. Patent 3,947,641, including claims 4 and 9 thereof. The Entraguard prototype that he developed for Marlee in late 1972 and early 1973 and which was shipped by ITC to Marlee for exhibition at a Miami trade show included each and every element set forth in claim 4 of the Trell patent. He described the circuitry of the Entraguard unit using words which he considered to be the equivalent of the words in the claim.

Had Marlee requested in 1973 that a direct access feature be included in the entry control system he was designing for them, the addition of such a feature would have been trivial.

He has reviewed U.S. Patent 3,633,167 (Hedin), and the addition of a keypad direct entry feature to the Entraguard system would have been obvious to an average designer of entry control systems in April 1973, based upon the Hedin patent alone.



The addition of a direct access feature, using the Entraguard's keypad and memory, to the Entraguard system would also have been entirely obvious in view of the combination of telephone entry and direct access which had already been provided for years by the Pacific Telephone entry control system described in the declaration and deposition transcript of Hector Ruiz, which he had reviewed.

5. James M. Leshner, who is president of an electronics and computer consulting company named Percentage Corporation, stated that:

Between October or November 1971 and March 1972, he redesigned the Identifone entry control system being sold by Dialalarm, Inc. to eliminate some problems the company had been experiencing with the magnetic tape version. The first such redesigned Identifone was installed in a customer's apartment building by Dialalarm in April 1972.

On December 27, 1972, he filed an application for a U.S. patent directed to the redesigned Identifone, which was assigned Serial No. 319,043. Also, some time in late 1972, he started working on a design which enabled the tenant to use their telephone's keypad instead of the hand-held tone generator, and constructed the first such unit.

On February 15, 1974, he filed a continuation-in-part application for U.S. patent. The CIP application was the same in content as, and claimed the priority of his 1972 patent application, except that it additionally described the use of the tenant telephone's keypad or dial as an alternative to the handheld tone generator to generate the door-opening tone from the tenant's telephone.

Attached as Exhibit 2 to his Declaration was a copy of patent 3,917,911, which issued to Mr. Leshner on November 4, 1975.

He has reviewed U.S. patent 3,947,641, including claims 4 and 9 thereof, and the Identifone unit which he developed in late 1972, and which was on sale and/or in public use prior to June 1, 1973 included each and every element set forth in

claim 4 of the Trell patent. He described the circuitry of the Identifone unit using words which he considered to be the equivalent of the words in the claim. Had anyone requested in 1973 that a direct access feature be included in the Identifone system, the addition of such a feature would have been obvious.

He has reviewed U.S. Patent 3,633,167 (Hedin), and the addition of a keypad direct entry feature to the Identifone system would have been obvious to an average designer of entry control systems in April 1973, based upon the Hedin patent alone.

He has reviewed the declaration of Hector Ruiz, and it is unthinkable that the Pacific Telephone system described by Mr. Ruiz could have failed to suggest to an ordinary circuit designer of entry control systems that one could combine telephone entry and direct access into a single entry control system, and use the dial or keypad of the entrance telephone for entry of both direct access code and the telephone entry code.

#### **Summaries Of The Declarations And Deposition Transcripts Filed In Opposition To Respondents' Renewed Motion For Summary Judgment.**

1. A License Agreement was entered into as of September 27, 1983, between Petitioner Anders Trell (Licensor) and Bewator Svensk Teleproduktion AB, a corporation of Sweden (Licensee).

Briefly stated, Bewator was granted the exclusive right to manufacture, use and sell the Invention in Europe, with the right to expand the license outside of Europe by making an additional payment of a non-recurring sum of 50,000 Swedish kronor per country. The first "Whereas" clause reads as follows:

"WHEREAS, the Licensor has invented an entry phone with a complimentary alarm function (herein designated as the "Invention"), which is connected to the regular telephone network. It is based on ideas



stated in the patents and patent applications as per Exhibit 1 to this Agreement."

Exhibit 1 contains a list of six (6) issued patents, one of which is "U.S.A. granted March 30, 1976, No. 3,947,641", the patent here in suit (P.A. 27a).

Licensee Bewator agreed to pay to Licensor Trell:

(a) A non-recurring sum of fifty thousand (50,000) Swedish kronor at the time the Agreement enters into effect,

(b) A royalty of 6% of the net invoice amount upon sale of devices pursuant to the Invention up to an aggregate amount of 20 million kronor and 4% thereafter, and

(c) A 30% share of gross sublicense revenues.

2. As of August 1, 1989, Petitioner granted a non-exclusive License in the United States under claim 9 of Trell patent 3,947,641 to Trigon Electronics, Inc., a California corporation, for a payment of \$10,000 for infringements occurring prior to August 1, 1989, and the payment of an earned royalty to Trell each calendar quarter at the rate of four (4) percent of the net selling price, excluding shipping charges and discounts, of all entry control systems sold by Trigon which embodied the invention disclosed in patent 3,947,641 and described in claim 9 thereof.

William A. Gagnon, President of Trigon Electronics, Inc. stated in his Declaration that:

During the settlement negotiations prior to the execution of the aforesaid License Agreement, he had briefly viewed copies of drawings pertaining to telephone security systems bearing the names of Pacific Telephone and General Telephone which had been sent to him by Mr. Richmond of Doorking, Inc. as being prior art regarding the Trell patent, but these did not dissuade him from going ahead with the settlement.

Trigon Electronics, Inc. now is and has been selling to General Telephone of California, Inc., Trigon telephone entry control systems which GTE installs and rents to its customers, which Trigon systems include the subject matter of claim 9 of Trell patent 3,947,641, and upon which Trigon now is and has been paying an earned royalty to Mr. Trell.

Declarant advised representatives of GTE that Trigon has been licensed under claim 9 of Trell patent 3,947,641, and is paying a royalty to Trell on the entry control systems with the direct access feature which GTE is purchasing from Trigon, which royalty has increased the price of the units with the direct access feature, and GTE is willing to pay an additional amount for the direct access feature.

3. On January 1, 1990, Anders E. Trell and Moscow Richmond, both individually and as President of Doorking, Inc., signed a Settlement Release And License Agreement under which Doorking, Inc. became licensed under Trell patent 3,947,641.

Pursuant to the aforesaid Agreement, Petitioner received a payment of \$125,000, \$25,000 of which was payment for the infringement of patent 3,947,641 which occurred prior to January 1, 1990 and \$100,000 was for a paid-up license, both of which payments were based upon a five (5) percent royalty on the apparatus. All of the entry control systems sold by Doorking, Inc. include the direct access feature of claim 9.

4. In a letter to Petitioner Trell dated May 17, 1990, Respondent Davis, President of Respondent Sentex stated that Sentex is willing to make Mr. Trell its exclusive distributor of its Infinity-System in Europe and the U.K., in exchange for a paid-up license under Trell's patent 3,947,641.

5. Walton Eugene Tinsley, Petitioner's patent expert stated in his declaration, in part, that:

I have a Degree in Electrical Engineering from the University of Cincinnati, a Masters Degree in Aeronautical

Engineering from the New York University, and a Juris Doctor Degree in Law from the University of Southern California. I have practiced patent law in Los Angeles since 1954, starting with the then firm Harris, Kiech, Foster & Harris, and am a partner in the succeeding firm Harris, Kern, Wallen & Tinsley. My practice has been in the field of patent and trademark law and I have prepared and prosecuted on the average of twenty-five patent applications per year, primarily in the electrical, electrochemical and mechanical fields. I have participated in and or conducted about a dozen patent infringement trials during that period.

In my senior year in electrical engineering I was given and completed a project of placing a portion of a telephone company central office in operation in the engineering department. I have prepared and prosecuted many patent applications for companies which develop equipment for the telephone companies or which utilize telephone company equipment, including Scantlan Electronics, Inc., now Quotron Systems, Inc. and Communications Technology Corporation.

The Entraguard system installed at the Miami Trade Show was programmed to dial the telephone number of the "tenant" telephone via the Miami public telephone network regardless of which code number was selected from the directory. See Ahlstrom Declaration page 5 lines 12-14. Such operation is the same as having a direct dedicated line from the prototype to the ordinary telephone representing the tenants telephone, and could readily be achieved by a direct connection between the units without using the public telephone system.

It is my opinion that the differences between the subject matter of the invention defined in the Trell patent claim 9 and the prior art relied on by defendants in their Motion for Summary Judgment are such that the subject matter as a whole would not have been obvious at the time the Trell invention was made, to a person having ordinary skill in the art to which said subject matter pertains.

*More specifically, a key feature of claim 9 is the provision of a unitary entry control system providing both (1) access to and verbal communication with a subscriber or tenant by a person seeking entry through the existing telephone company central office network using one code number, and (2) actuation of the door lock mechanism by the person seeking entry using another code number, with a discriminating means permitting transmission only of certain numbers.*

While components can be selected from the various items of prior art and combined in the manner taught by the Trell patent in order to produce the apparatus of claim 9, there is nothing in any of the prior art which contains any teaching or suggestion of the concept of such a combination.

The prior art and defendants Declarants show that a considerable number of skilled workers in this field in the early 1970s were developing a variety of access control systems. However none of these people, who had at least ordinary skill in this field and who had other concepts, most of which were reduced to practice and a number of which were manufactured and sold commercially, came up with Mr. Trell's admittedly unique concept. It is submitted that the opinions on obviousness in the Declarations filed by defendants are based on hindsight and are not correct.

The basis for my opinion is set out in the following discussion wherein each of the defendants Declarations is considered separately.

### **The District Court's Weighing Of The Evidence And Its Adjudications Of The Genuine Issues As To The Material Facts.**

#### **Regarding Claim 4**

The District Court accepted as true, the statements of Respondent Sentex's employee John Ahlstrom and Robert Margolis that the Entraguard was "demonstrated" at the "Apartment Builder/Developer Conference and Exposition" in Miami, Florida on April 2-4, 1973 (P.A. 6a).

The District Court further stated: "Through the declaration of John Ahlstrom defendants have proffered evidence that the device was connected to the Miami public telephone system" (P.A. 9a).

The District Court further accepted as true, the statement of Respondents' Declarant Robert Margolis that an order for an Entraguard unit was placed on May 15, 1973 and was shipped to a customer on June 1, 1973 (P.A. 7a), even though the "invoice" shows that it was a "will call" (W/C) (P.A. 26a).

The District Court failed to understand the significance of the statement of Petitioner's patent expert Tinsley that with the prototype Entraguard at the trade show in Miami being programmed to dial the "tenant" telephone regardless of the number which was dialed using the selecting means, it was the same as having a direct dedicated line from the prototype to the ordinary telephone representing the tenant's telephone, and could readily be achieved by a direct connection between the units without using the Miami public telephone system.

The District Court concluded that this argument is irrelevant, stating (P.A. 9a-10a).

"The plaintiff argues that the device used at the Miami tradeshow was no different than having a dedicated line. However, this argument is irrelevant. The important point is that the device required the use of the code to activate the mechanism which would then use the public phone network to call the receiving phone".

The District Court accepted as true, the statement (opinion?) of Respondents' Declarant Don Janess . . . whom the court determined was a person having ordinary skill in the art . . . as "tracking" claim 4 of the patent with his description of the Entraguard as demonstrated at the Florida trade show in 1973, which show Mr. Janess did not attend (P.A. 8a-9a).

The District Court termed "uncontradicted evidence" (without any documentary evidence in support thereof), the statement of Respondents' Declarant James Leshner that the first devices known as the Identifone were sold in 1972 (P.A. 7a). The District Court also accepted as true, Mr. Leshner's statement (without any documentary evidence) that the device was first installed in an apartment building in April 1972 (P.A. 10a).

The District Court further accepted as true, the statement (opinion?) of Mr. Leshner... whom the court determined was a person having ordinary skill in the art... describing the construction and operation of the Identifone unit by following the wording of claim four, which the Court determined "exactly tracks the elements in claim four of the '641 patent" (P.A. 11a).

The District Court determined as a matter of law by its study of the Trell patent and the Identifone patent, that the hand held tone generator of the Leshner patent "appears to fall within the parameters of claim four of the '641 patent" with regard to "means responsive to signals induced from said subscriber telephone for thereupon releasing said door lock" (P.A. 11a).

### Regarding Claim 9

The District Court accepted as true, the statements contained in the Declaration of Hector Ruiz regarding the Pacific Telephone system (P.A. 13a-15a).

Yet, Mr. Ruiz did not produce a single drawing or a single schematic wiring diagram to substantiate any of his statements.

The District Court did not find the declaration of Petitioner's patent expert W. E. Tinsley to be persuasive (P.A. 17a).

The District Court did not find the declaration of Petitioner's technical expert Heinlein to be persuasive because



he does not have "the requisite ordinary skill in the art" (P.A. 17a).

The District Court found otherwise as to the declarations submitted on behalf of Respondents, stating (P.A. 18a):

"On the other hand, the defendants have presented the declarations of Janess, Ahlstrom and Leshner that the addition of the Pacific Telephone system's use of the entryway telephone dial for the entry of both the telephone codes and entrance codes to either the Entraguard or the Identifone was obvious in 1972-73. Decl. of Ahlstrom para. 14-16, Decl. of Janess, para. 10-11, Decl. of Leshner, para. 17-18".

The District Court had determined that "Messrs. Janess, Ahlstrom and Leshner were each persons of ordinary skill in the art in the April 1973 time frame".

With regard to the "secondary considerations" of commercial success referred to in *Graham v. John Deere Co.*, 383 U.S. 1, 15 L.Ed.2d 545, 86 S.Ct. 684 (1966), the District Court stated:

"The plaintiff also produces evidence of a license between Trell and Bewator Svensk Teleproduktion. However, that license only applies to European patents. The validity of any patents in Europe is not affected by a finding of invalidity in the United States as patents are governed by laws of their respective countries. Again, Trell has not shown the required nexus (P.A. 19a-20a).

"The last two licenses that Trell produces are the Door King and the Trigon licenses. The court does not find these licenses persuasive. First, the evidence is barred by Federal Rule of Civil Procedure 408 since they are the product of settlements. Moreover, even if this court were to admit the evidence, as shown by the deposition presented by the defendants, the Door King license was motivated by the desire to settle litigation. See Depo. of Richmond pp. 58-60. In addition, the

Trigon license was based on the erroneous belief that the federal circuit opinion in *Marlee* upheld the validity of claim nine. Depo. of Gagnon, pg. 37. The plaintiff has presented no evidence that would contradict this and has consequently failed to establish the requisite nexus" (P.A. 20a).

## REASONS FOR GRANTING THE WRIT

1. It was improper for the District Court to conduct a trial by declarations of the issue of patent claim validity under the guise of deciding a motion for summary judgment, and to accept as being true, all of the unsupported statements contained in the declarations filed in support of the motion, and to reject as not being persuasive, all of the declarations and evidence filed in opposition to the motion.

In *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 91 L.Ed.2d 202, 106 S.Ct. 2505 (1986), this Court made several statements of the law applicable to cases involving motions for summary judgment, which are very pertinent to the present situation.

Firstly, the Court stated at 477 U.S. 249 as follows:

"Our prior decisions may not have uniformly recited the same language in describing genuine factual issues under Rule 56, but it is clear enough from our recent cases that at the summary judgment stage the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial."

It is indicated by the act of the district court in permitting (suggesting?) the filing of the Renewed Motion For Summary Judgment Of Invalidity Of Claims 4 And 9 after the time for the filing of motions for summary judgment had passed, that the district court was intent on disposing of the case at the summary judgment stage.



Next, this Court stated as follows at page 477 U.S. 242 regarding the evidentiary standard of proof:

“Progressing to the specific issue in this case, we are convinced that the inquiry involved in a ruling on a motion for summary judgment or for a directed verdict necessarily implicates the substantive evidentiary standard of proof that would apply at the trial on the merits.”

In patent cases, 35 U.S.C. § 282 mandates that a patent is presumed to be valid and that the burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity. The great weight of the reported cases hold (and the district court admitted) that this presumption can be overcome only by clear and convincing evidence.

In *Buildex, Inc. v. Kason Industries, Inc.*, 849 F.2d 1461, 1463 (Fed.Cir. 1988), the court stated that “‘clear and convincing’ evidence has been described as evidence which produces in the mind of the trier of fact ‘an abiding conviction that the truth of [the] factual contentions are ‘highly probable’”’, citing *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984).

And lastly, this Court stated as follows at page 477 U.S. 255:

“Our holding that the clear-and-convincing standard of proof should be taken into account in ruling on summary judgment motions does not denigrate the role of the jury. It by no means authorizes trial on affidavits. Credibility determinations, the weighing of the evidence, and the drawing of legitimate inferences from the facts are jury functions, not those of a judge, whether he is ruling on a motion for summary judgment or for a directed verdict. *The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor*” (Emphasis added.).

In its Memorandum Of Decision And Order, the District Court referred to many of the well-established rules of law to be applied in deciding motions for summary judgment in patent cases, including that the evidence must be viewed in a light most favorable to the non-moving party and that the presumption of patent validity can be rebutted only with clear and convincing evidence.

Unfortunately, the District Court disregarded all of these established rules of law, and adjudicated the matter now before this Court by the simple expediency of accepting as being true, all of the statements contained in the declarations filed in support of the Renewed Motion For Summary Judgment, and by rejecting as not being persuasive, all of the declarations and evidence filed in opposition to the Motion.

Turning first to claim 4 which requires that the apparatus be used in combination with a public automatic subscriber telephone network, the District Court found that the Entraguard was "demonstrated" at the show in Miami, Florida, based solely upon the declarations of Messrs. Margolis and Ahlstrom, and that "through the declaration of John Ahlstrom defendants have proffered evidence that the device was connected to the Miami public telephone network".

Contrasted with these unsupported statements are the following facts:

- There is no documentary evidence that two telephone lines were ordered for the Trade Show in Miami, Florida, or that Marlee paid for the installation and use of two telephone lines.

- There is no documentary evidence or even a statement by any of Messrs. Margolis, Ahlstrom and Janess, that the single prototype Entraguard unit was tested prior to being shipped to Miami, to determine whether it was capable of being used in combination with the Miami public telephone network, or with any public telephone network.

- There is no documentary evidence or even a statement by any of Messrs. Margolis, Ahlstrom and Janess that after the Trade Show and prior to petitioner's invention date of June 7, 1973, the Entraguard prototype (or any other Marlee entry control device) was installed in an apartment building and used in combination with a public telephone network to admit visitors to the apartment, as described in claim 4.

The District Court further stated: "There is evidence that an Order for an Entraguard unit was placed on May 15, 1973, and was shipped to a customer on June 1, 1973. Decl. of Margolis, para. 9. The Entraguard thus predates patent '641".

Exhibit 6 to the Margolis declaration is a photocopy of an invoice dated June 5, 1973, which contains the letters "W/C" under the "box" which contains the words "Shipped via" (P.A. 26a). It is common knowledge that the letters "W/C" are used to designate "will call".

Thus, there is no evidence of the date when the single unit . . . which might have been the prototype displayed at the trade show in Miami . . . was picked up by a purchaser; nor is there any evidence when it was installed, if at all.

With regard to the construction features of the Entraguard prototype, the District Court relied solely on the description by Mr. Janess of an apparatus which he purportedly designed some eighteen (18) years ago, which description the Court found "exactly tracks claim four of the '641 patent".

With regard to the Identifone unit, the District Court relied solely on the statements in Mr. Leshner's Declaration that it was sold in the United States in 1972 and was first installed in an apartment building in April 1972. Here again, there is no documentary evidence whatsoever such as orders, invoices, receipts, and the like . . . only Mr. Leshner's memory of what occurred some eighteen (18) years ago.

As with the Entraguard unit, for the construction features of the Identifone unit the District Court relied upon Mr. Leshner's description "which exactly tracks the elements of claim four of the '641 patent".

The District Court further determined as a matter of law, by merely reading the Trell patent and the Identifone patent that the hand held tone generator of the Identifone system met the claim four requirement regarding signals induced from said subscriber telephone.

This simplistic approach (and the results) is clearly contrary to the holding in *Lindemann Maschinenfabrik v. Am. Hoist And Derrick*, 730 Fed.2d 1452, 1458 (Fed.Cir. 1984), wherein the court stated as follows:

"In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference."

This same fatal error of the District Court occurred when it accepted the statements contained in the declarations of Messrs. Janess and Leshner as "tracking claim 4 of the '641 patent".

With regard to claim 9, the District Court relied upon the declaration and deposition testimony of Hector Ruiz (as "clear and convincing" evidence?) for the construction and operation of the so-called Pacific Telephone entry control system, without there being a single drawing or a single schematic wiring diagram to substantiate any of his descriptions.

Furthermore, the District Court erroneously relied upon the "opinions" of Messrs. Janess, Ahlstrom and Leshner for determining that an unspecified manner of adding the entryway telephone dial of the Pacific Telephone system to the Entraguard or the Identifone was obvious in 1972-1973.

Firstly, the District Court had determined that each of these men was a person of ordinary skill in the art in the April 1973 time frame. Accordingly, their "opinion" testimony was inadmissible (Rule 701 of the Federal Rules Of Evidence). Furthermore, any such opinion based on the declaration or deposition testimony of Mr. Ruiz is inadmissible as being based on hearsay.

Secondly, all three were purportedly actively engaged in the designing of the Entraguard and Identifone units at that time, but none thought of adding the Pacific Telephone entryway telephone dial to the unit he was designing.

Mr. Ahlstrom stated that "we" had discussed adding a direct access feature to the Entraguard, but neither Mr. Margolis nor Mr. Janess who were involved with him in designing the Entraguard corroborated this statement.

Turning lastly to the three (3) License Agreements entered into by Mr. Trell, which the District Court rejected as not being persuasive, the Court stated that the Bewator license only applies to European patents. To the contrary, the Bewator Agreement specifically lists "U.S.A." patent No. 3,947,641 as being included within its terms (P.A. 27a).

With regard to the rejection of the Trigon and Doorking license agreements as being barred by Rule 408 of the Federal Rules of Evidence, this rule clearly does not apply to the terms for the settlement of patent litigation, as contained in a settlement agreement and/or license agreement.

With regard to the purported failure of Petitioner to establish a "nexus" between claim 9 of the patent and the Trigon and Doorking license agreements, both Mr. Gagnon and Mr. Richmond obviously recognized that they could manufacture and sell other types of telephone entry control systems, but each separately determined that it was economically advantageous for his respective company to be able to manufacture and sell a telephone entry control

system which embodied the subject matter of claim 9 of the '641 patent.

2. In District Court erred in granting summary judgment that claims 4 and 9 are invalid, because Respondents failed to carry their burden of showing that there is no genuine issue as to any material fact.

In *Adickes v. Kress & Co.*, 398 U.S. 144, 26 L.Ed.2d 142, 90 S.Ct. 1598 (1970), this Court stated as follows at 398 U.S. 157:

“As the moving party, respondent had the burden of showing the absence of a genuine issue as to any material fact, and for these purposes the material it lodged must be viewed in the light most favorable to the opposing party.”

The District Court also admitted in its “Memorandum Of Decision And Order” that Sentex, the moving party, bears the burden of demonstrating that no issues of material fact exists, and that the evidence must be viewed in a light most favorable to the non-moving party (P.A. 5a).

However, there were numerous genuine issues as to material facts in the present case, which the District Court erroneously decided adversely to Petitioner, including the following:

1. The actual construction features of the Pacific Telephone system prior to Petitioner's invention date of June 7, 1973, which system was described by Mr. Ruiz without any documentary evidence.

2. The actual construction features of the Entraguard and Identifone units prior to Petitioner's invention date of June 7, 1973, which Messrs. Janess and Leshner described by “tracking” claim 4.

3. Whether the Entraguard and Identifone units were actually used in combination with a public automatic telephone network as described in claim 4, prior to Petitioner's invention date of June 7, 1973, or were even capable of



being so used, i.e., whether there was an actual reduction to practice prior to that date.

In *Great Northern Corp. v. Davis Core & Pad Co., Inc.*, 782 F.2d 159, 135 (Fed.Cir. 1986), the court stated as follows regarding a reduction to practice:

"The District Court concluded, correctly we hold, that the invention was not reduced to practice until after February 28, 1977, and, therefore, the testing prior to that date did not constitute a § 102(b) bar.

"The '732 support was not reduced to practice until it was sufficiently tested to demonstrate that it would work for its intended purpose, . . .".

3. It was error for the District Court to adjudicate the validity of independent claim 4 as to which there was no actual controversy under 28 U.S.C. § 2201, for the purpose of facilitating its determination of invalidity of dependent claim 9.

In *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 905 (Fed.Cir. 1988), the court stated the established law as follows:

"There is no question that a case or controversy is a jurisdictional predicate for declaratory judgment under 28 U.S.C. § 2201. [cases] And 'an actual controversy must be extant at all stages of review, not merely at the time the complaint is filed.' *Preiser v. Newkirk*, 422 U.S. 395, 401, 95 S.Ct. 2330, 2334, 45 L.Ed.2d 272 (1975). The actual controversy requirement precludes a declaration about the validity of claims unless the defendant objectively has a 'reasonable apprehension that it will face an infringement suit' on those claims."

In the present case, the following facts clearly show that Respondents did not have a reasonable apprehension that they will face an infringement action on claim 4:

1. The infringement notice letter of March 7, 1989 to Respondent Sentex was specifically limited to claim 9.

2. Both the original Complaint and the First Amended Complaint were specifically limited to the alleged infringement of claim 9.

3. Plaintiff's Answer To Counterclaim denies there was an actual controversy as to any claim, other than claim 9.

Respondents desired that the issue of the validity of claim 4 be included so they could argue and the District Court could state that claim 9 merely adds a direct access feature to claim 4, instead of the District Court following the mandate of 35 U.S.C. § 103 and the well established rule of law that the subject matter of a dependent claim such as claim 9, must be viewed as a whole in determining the legal issue of non-obviousness, i.e., as including all of the limitations in both claim 4 and claim 9.

This maneuver was successful because the District Court erroneously stated as follows (A.P. 17a):

"However, after considering the evidence that has been presented, this court is of the opinion that a genuine issue of material fact does not remain for trial. Claim nine of the '641 patent is merely the combination of the Entraguard and the direct access feature of the Pacific Telephone system or the combination of the Identifone and the direct access feature of the Pacific Telephone system. Using the *Winslow* analogy, this court is convinced that an inventor with the ordinary skill in the art when confronted with the problem of trying to add a direct access feature to the Entraguard or the Identifone, would see the obviousness of combining the direct access feature of the Pacific Telephone system with the Entraguard or the Identifone."

As can be explained in a Brief On The Merits, the so-called *Winslow* analogy does not apply to the present case because there was no credible evidence that any of Ruiz, Margolis, Ahlstrom, Janess and Leshner had the concept prior to Petitioner's invention date of June 7, 1973, of a



telephone entry control system with discriminating means being used in combination with a public subscriber telephone network, and having a direct access feature which utilized the same selecting means and discriminating means.

Petitioner's patent expert Tinsley pointed this out in his Declaration (page 14, *supra*).

And, Respondent's attorney recognized the absence of this proof in the evidence, and accordingly, in "Order (Proposed) Granting Defendants' Renewed Motion For Summary Judgment Of Invalidity Of Patent Claims 4 And 9", he changed the basis for the District Court's holding of invalidity of claim 9 to omit any reference to *In re Winslow*, 365 F.2d 1017, 1020 (CCPA 1966).

### CONCLUSION

This Petition should be granted, to deter a practice by which district courts dispose of troublesome patent cases by conducting a trial on declarations under the guise of deciding a motion for summary judgment, and by accepting as being true, all of the statements contained in declaration filed in support of the motion, and by rejecting as not being persuasive, all of the statements and evidence contained in declarations filed in opposition to the motion.

Respectfully submitted,

CHARLES E. WILLS  
*Counsel for Petitioner*



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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

ANDERS E. TRELL,  
*Plaintiff and Counterdefendant,*

VS.

SENTEX SYSTEMS, INC., and  
WILLIAM R. DAVIS,  
*Defendants and counterclaimants.*

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CASE NO. CV 89-3355 DT

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MEMORANDUM OF DECISION AND ORDER

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Defendants' and counterclaimants', Sentex Systems, Inc.'s and William R. Davis's, Renewed Motion For Summary Judgment came on regularly for hearing before the undersigned on August 20, 1990.

Charles E. Wills, Esq., a member of Charles E. Wills Law Corporation, appeared on behalf of the plaintiff and counterdefendant, Anders E. Trell.

Robert A. Seldon, Esq., of the law firm of Ashen, Martin, Seldon, Lippman & Scillieri, appeared on behalf of the defendants and counterclaimants, Sentex Systems, Inc. and William R. Davis.

Written evidence was presented to the Court. Written and oral argument made on behalf of the respective parties was presented and considered by the Court. The Court, now feeling fully advised, rules and adjudges as follows:

Defendants' and counterclaimants, Sentex Systems, Inc.'s and William R. Davis's, Renewed Motions For Summary Judgment are granted. Claims 4 and 9 of United States Patent No. 3,947,641 are declared invalid by this Court under 35 U.S.C. §§ 102(a), 102(b) and 103.

### *Background*

This case stems from a patent, United States Patent No. 3,947,641 (" '641 patent"), issued on March 30, 1976 to Plaintiff Anders Trell for an invention titled "Use of Public Subscriber Telephone Network; Method and Apparatus."

Trell's patent contains two claims at issue: claim four and claim nine. Claim four covers an invention which includes a telephone mounted outside a locked building. The telephone allows a visitor to contact and speak with someone within the building through standard public telephone lines. The person within the building then can depress a push-button on his telephone which sends a signal through the public telephone lines and causes the entrance door to be unlocked, thereby enabling the visitor to enter the building.

Claim nine embodies claim four and adds a direct access feature which allows the visitor to unlock the door by entering a programmed number into the telephone keypad.

The '641 patent describes claim four as follows:

In combination with a public automatic subscriber telephone network an apparatus having connecting means by which the apparatus can be connected to a door lock, comprising:

switching means by which said apparatus can be coupled onto a telephone line going out to the automatic exchanges of said telephone network;

selecting means for dialing telephone numbers to said telephone network;

discriminating means for securing that only certain telephone numbers out of all those of the whole said telephone network can be selected resulting in said telephone networks performing a call to one of said telephone networks subscriber telephone sets;

means for verbal communication with said subscriber telephone; and

means responsive to signals induced from said subscriber telephone for thereupon releasing said door lock.

Claim nine states: "The combination of claim four, wherein said selecting means also addresses a common combination lock devise." Thus, claim nine ostensibly adds an apparatus which causes the door lock to open upon the receipt of a previously programmed sequence of numbers entered at the building's entrance.

Trell claims that Sentex Systems Inc. has infringed on claim nine of the '641 patent. On June 1, 1989, Trell filed a patent infringement suit against Sentex Systems Inc. and its president, William R. Davis (hereinafter collectively "Sentex"). A first amended complaint was filed on July 28, 1989.

On August 21, 1989, Sentex filed its answer to Trell's first amended complaint. Sentex also asserted a counterclaim for declaratory relief seeking to invalidate claims four and nine of Trell's patent.

On May 7, 1990, Sentex filed a motion for summary judgment invalidating claims four and nine of the '641 patent. This motion was denied without prejudice on June 28, 1990. Sentex renewed its motion for summary judgment on June 18, 1990. Trell filed an opposition on July 2, 1990, and Sentex filed its reply on July 9, 1990. In addition to the aforementioned motions, this court has entertained several motions concerning discovery disputes.

Pertinent to the present case is a previously litigated case concerning the '641 patent between Trell and Marlee Electronics Corp. styled *Trell v. Marlee Electronics Corp.*, No. 85 Civ. 7364-DT (1987) ("*Marlee*"). In *Marlee*, this court narrowly construed the '641 patent in holding (1) that the '641 patent was valid, and (2) that the Marlee *Entraguard* system did not infringe on the '641 patent. This court was reversed on appeal by the Federal Circuit, No. 88 Civ. 1099 (1989). Contrary to this court's holding, the



Federal Circuit broadly construed the '641 patent. Significantly, the issue of claim nine's validity was not raised on appeal before the Federal Circuit. Thus, this court now examines anew the validity of the '641 patent in light of the Federal Circuit's broad construction of the patent.

Defendants' (moving parties') contentions can be summarized as follows:

1. The presumption of invalidity may be overcome by new evidence.
2. The *Entraguard* and the *Identiphone* anticipate claim four of the '641 patent.
3. Combination of the *Entraguard* or the *Identiphone* with the Hedin patent, the Pacific Telephone system, or the General Telephone System renders claim nine obvious.

Plaintiff's opposition can be summarized as follows:

1. Claim four is not properly before the court.
2. The *Graham* test requires consideration of secondary considerations.
3. The licenses and the commercial success of the Trell invention indicate that claim nine is not obvious.
4. The combination suggested by the defendants in their claim that claim nine is invalid is an impermissible selective combination.
5. Neither Janess, Margolis, and Leshner are qualified patent experts.

The defendants' reply can be summarized as follows:

1. The proffered declarations fail to raise any genuine issues of material fact.
2. Plaintiff's evidence of commercial success is inadequate to show the presence of secondary considerations.

3. There is no selective combination.
4. Plaintiff's statement of genuine issues does not contain any genuine issues of material fact.

### Discussion

#### A. The Standard

As in other cases, summary judgment in a patent case is appropriate where, viewing the evidence in a light most favorable to the non-moving party, there are no genuine issues of fact and the moving party is entitled to judgment as a matter of law. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1141 (Fed. Cir. 1986) (*Hodosh*). Sentex, the moving party, bears the burden of demonstrating that no issues of material facts exist. *Id.*

Because this current motion is brought by Sentex to invalidate an existing patent, Sentex also bears the burden of overcoming the presumption of a patent validity conferred by 35 U.S.C. § 282.<sup>1</sup> "This presumption may be rebutted only with clear and convincing evidence." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050 (Fed. Cir. 1988) (*Uniroyal*). If Sentex succeeds in establishing a prima facie case of invalidity, Trell must come forward with sufficient evidence to counter the challenge. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1022 (Fed. Cir. 1985). In order to overcome summary judgment after a prima facie showing of invalidity, Trell "must show an evidentiary conflict on the record; mere conclusory statements are not sufficient." *Hodosh*, 786 F.2d at 1141.

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<sup>1</sup>35 U.S.C. § 282 states in pertinent part that "[a] patent shall be presumed valid. Each claim of a patent (whether in independent, dependant or multiple dependant form) shall be presumed valid independently of the validity of other claims; dependant or multiple dependant claims shall be presumed valid even though dependant on an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such validity."

Sentex argues that claim four of the '641 patent is invalid because it was anticipated by prior art under 35 U.S.C. § 102(a). In addition, Sentex seeks to invalidate claim nine of the '641 patent because the invention was obvious pursuant to 35 U.S.C. § 103.

## B. Claim Four

This court will first address the issue of the validity of claim four of the '641 patent.

### 1. Scope and Content of Prior Art.

Trell's U.S. patent application was filed on June 3, 1974; however, Trell apparently filed a patent application in Sweden on June 7, 1973. Trell's invention date is deemed to be his Swedish filing date of June 7, 1973. *Yaskuto Kawai v. Metlesics*, 480 F.2d 880 (CCPA 1973). Thus, for the determination of obviousness, this court will consider entry control systems which were known or used in the United States before June 7, 1973, 35 U.S.C. § 102(a), systems which were in public use or on sale in the United States prior to June 3, 1973, 35 U.S.C. § 102(b), and systems described in United States patents issued on applications filed before June 7, 1973, 35 U.S.C. § 102(e).

Sentex cites five examples of prior art which purportedly made Trell's invention obvious: the Marlee *Entraguard*, the Leshner *Identiphone*, the Patent to Hedin, the Pacific Telephone Entry Control System, and the General Telephone System. This court finds that it need not discuss all of the systems presented by the defendants. This court will only be concerned with the *Entraguard* and *Identiphone* systems for the purpose of deciding the defendants' motion for summary judgment as to claim four of the '641 patent.

#### a. The Marlee *Entraguard*

The *Entraguard* was demonstrated at the "Apartment Builder/Developer Conference and Exposition" in Miami Florida on April 2-4, 1973. Decl. of Margolis, para. 7; Decl.

of Ahlstrom, para. 11. There is evidence that an order for an *Entraguard* unit was placed on May 15, 1973, and was shipped to a customer on June 1, 1973. Decl. of Margolis, para. 9. The *Entraguard* thus predates patent '641.

The *Entraguard* system employed a telephone to be placed at the entrance of a locked building from which a visitor could contact someone within the building through standard public phone lines. The person inside the building then could cause a door to unlock by depressing a button on the phone.

b. The Leshner *Identiphone* System

The defendants have presented uncontradicted evidence that the first devices known as the *Identiphone* were sold in 1972. Decl. of Leshner, para. 4. According to the declaration of James Leshner, the *Identiphone* was used outside locked buildings. A visitor to the building would dial into the *Identiphone* a three digit number corresponding to the occupant that he wished to visit. The device would retrieve from a magnetic tape recording device the telephone number of the occupant sought, and dialing through the public telephone system, cause the occupant's telephone to ring. The calls placed from the *Identiphone* were restricted to the telephone numbers stored in the magnetic recording device so that only telephones of tenants could be reached from the *Identiphone*. Decl. of Leshner, para. 4, 5.

Using the telephone handset of the *Identiphone*, the visitor identified himself to the occupant. If the tenant wished to admit the visitor, he used a hand-held tone generator near the mouthpiece of his telephone. The *Identiphone* would recognize the signal and cause the door to unlock. Decl. of Leshner, para. 4.

At the end of 1971, Leshner redesigned the *Identiphone* to use a digital memory for storing the telephone numbers of occupants. On December 27, 1972, Leshner caused a patent application on the redesigned *Identiphone* to be filed. Decl. of Leshner para. 8.

Finally, the plaintiffs have presented evidence that at least some of the *Identiphones* sold in 1972 had "Postman's Locks," mechanical locks owned and installed by the U.S. Postal Service. The postman carries a key which fits the lock, and he uses the key to bypass security systems and open entrance doors for mail delivery. In the *Identiphone*, a microswitch was positioned to contact the mechanical bolt of the postman's lock. When the postman turned his key in the lock, the microswitch responded to the bolt's movement by activating circuitry which energized the door strike of the door.

## 2. Anticipation.

35 U.S.C. § 102(a), provides, in pertinent part:

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, . . ."

35 U.S.C. § 102(a). "[I]n order to have anticipation, all of the elements of the patented device or their equivalents must be found in a single prior device." *Amphenol Corporation v. General Time Corporation*, 397 F.2d 431 (7th Cir. 1968)

### a. The *Entraguard*

The defendants have presented the Declaration of Don Janess, the person who developed the *Entraguard* device used at the Florida tradeshow in which he describes the *Entraguard*, as demonstrated at the Florida tradeshow in 1973. In his declaration, Janess states that the *Entraguard* device used at the trade show "[w]orked in combination with [a] public subscriber network, and included terminals for electrically connecting to a door lock; included [a] switching circuit responsive to entry of a valid tenant code to seize [the] line to [the] automatic exchange of the network; included [a] keypad for entering a code number

which accessed memory and a circuit for dialing corresponding telephone numbers to the network; included [a] memory and access circuit which insured that only telephone numbers pre-programmed into [the] memory could be selected, resulting in the call being performed to one of the network subscriber sets; i.e. the tenant's phone; included a telephone handset for verbal communication between [the] Entraguard and [the] tenant's telephone; [and] included a circuit responsive to the tone or pulses from the tenant's telephone to release the door lock." Decl. of Janess, para 7. This description exactly tracks claim four of the '641 patent.

Moreover, the plaintiff himself admits that there are no differences between the *Entraguard* and the system defined in claim four of the '641 patent. Trell Depo. Vol. I pg. 149.

In his opposition, the plaintiff argues that Janess has not been qualified as a patent expert. However, this court is not relying on the Janess declaration insofar as it may express an expert opinion. This court is concerned with the facts stated in that declaration. Therefore, Janess's qualifications as an expert are irrelevant.

The plaintiff also attacks the *Entraguard* evidence by stating that the shipment of the device to Florida does not show that the device utilized the public subscriber network. This contention is without merit. Through the declaration of John Ahlstrom, defendants have proffered evidence that the device was connected to the Miami public telephone system. Plaintiff's mere bald assertions to the contrary are not sufficient to challenge this declaration. *Harper v. Wallingford*, 877 F.2d 728 (9th Cir. 1989).

Finally, the plaintiff attacks the *Entraguard* evidence on the grounds that the device would dial the same phone number no matter what code was entered. See Decl. of Tinsley para, 23. The plaintiff argues that the device used at the Miami tradeshow was no different than having a dedicated line. However, this argument is irrelevant. The important point is that the device required the use of the code to



activate the mechanism which would then use the public phone network to call the receiving phone. The plaintiff has presented no evidence that contradicts any of the facts presented in the declarations of Janess or Ahlstrom.

The defendants have put forth evidence that a device embodying each and every element of claim four of the '641 patent was in use prior to the Trell invention date. The plaintiff has not presented any evidence that would show that a material issue of fact is present as to any of the elements of claim four. Indeed, the defendants have presented the deposition testimony of the plaintiff in which he admits that each and every element of the invention described in claim four is found in the *Entraguard*. Therefore, the defendants' motion for summary judgment is granted as to the invalidity of claim four of the '641 patent.

b. *The Identiphone*

As an alternative route to invalidating the '641 patent, the defendants present evidence of the device known as the *Identiphone*. The defendants rely on the incarnation of the *Identiphone* which was developed by James Leshner early in 1972. That device was first installed in an apartment building in April, 1972.

In his declaration, Leshner describes the *Identiphone* as one that "worked in combination with [a] public subscriber network, and included terminals for electrically connecting to a door lock; included [a] switching circuit responsive to entry of valid tenant code to seize line to automatic exchange of [the] network; included dial for dialing telephone numbers to the network; included a memory and access circuit which insured that only telephone numbers pre-programmed into [the] memory could be selected, resulting in the call being performed to one of the telephone subscriber sets; i.e. the tenant's phone; included a telephone handset for verbal communication between [the] *Identiphone* and [the] tenant's telephone to release the door lock." Decl. of Leshner, para. 12.



The court has also reviewed the Leshner patent, Patent No. 3,917,911, excluding those elements that were the product of the 1974 continuation-in-part application, and finds the description as provided by James Leshner is consistent with U.S. Patent No. 3,917,911. In addition, the description provided by Leshner exactly tracks the elements in claim four of the '641 patent.

In his opposition, the plaintiff attacks the declaration of Leshner on the grounds that Leshner has not been qualified as a patent expert. However, this court is not relying on the Leshner declaration for expert opinions. The court is only concerned with his description of the device he developed. Therefore, whether Leshner is qualified as a patent expert is irrelevant.

The plaintiff also attacks the proposition that the *Identiphone* anticipates claim four of the '641 patent because the *Identiphone* employs a handheld tone generator to activate the mechanism releasing the door lock rather than using signals generated by the telephone unit itself; thus, according to plaintiff, the *Identiphone* did not anticipate claim four of the '641 patent because the signal causing the release of the door lock was not a result of the tenant "actuat[ing] his or her telephone to induce signals for releasing the door."

The pertinent language of claim four states that the invention uses "means responsive to signals induced *from* said subscriber telephone for thereupon releasing said door lock." (emphasis added). Claim four of the '641 patent does not require that the signals releasing the door lock must be generated *by* the subscriber telephone; the patent only requires the signal to come *from* the subscriber telephone. Therefore, the hand held tone generator appears to fall within the parameters of claim four of the '641 patent.

Plaintiff argues that whether the tone generator does fall within the terms of claim four is a question of fact for trial. Insofar as the plaintiff is claiming that there is a question as to the meaning of the pertinent patent language, the plaintiff's argument is not well founded. Interpretation of a

patent claim is a matter of law. *Rayethon Co. v. Roper Corp.*, 724 F.2d 951, 956 (Fed. Cir. 1983). Because this court has before it both the Trell patent and the *Identiphone* patent and "the scope and content of those patents [is] easily discernible, no testimony, expert or otherwise, regarding their scope and content is necessary." *Chore-Time Equipment v. Cumberland*, 713 F.2d 774, 779 (Fed. Cir. 1983)

The defendants have presented evidence that each and every element of claim four of the '641 patent is contained in the *Identiphone*. The defendants have also presented evidence that the *Identiphone* was being sold in the United States in 1972. The plaintiffs have not presented any evidence that contradicts the evidence presented by the defendants. The plaintiff has failed to present any evidence or point to any facts which would indicate that a material issue of fact remains for trial. Therefore, the defendant's motion for summary judgment as to the invalidity of claim four of the '641 patent is also granted on the grounds that claim four was anticipated by the *Identiphone*.

### C. Claim Nine

The defendants seek to invalidate claim nine of the '641 patent as obvious pursuant to 35 U.S.C. § 103. 35 U.S.C. § 103 provides, in pertinent part:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103 (Supp. 1990).

"Obviousness under 35 U.S.C. § 103 is a legal conclusion involving a preliminary determination of four factual inquiries: (1) the scope and content of prior art; (2) the

differences between the claims and prior art; (3) the level of skill in the pertinent art; (4) secondary considerations, if any, of nonobviousness. Secondary considerations include objective indicia of nonobviousness such as commercial success, long-felt but unsolved need, and failure of others." *Uniroyal*, 837 F.2d at 1050, citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

### 1. The Scope and Content of Prior Art

In attacking the validity of claim nine of the '641 patent, the defendants cite five examples of prior art which purportedly made Trell's invention obvious: the Marlee *Entraguard*, the Leshner *Identiphone*, the Patent to Hedin, the Pacific Telephone Entry Control System, and the General Telephone System. This court finds that it need not discuss all of the systems presented by the defendants. The court is only concerned with the *Entraguard*, the *Identiphone*, and the Pacific Telephone Entry Control System.

This court has previously discussed the *Entraguard* and *Identiphone* systems. As noted above, both systems anticipate claim four of the '641 patent. The court will now turn to the Pacific Telephone System.

#### a. The Pacific Telephone System

According to the Declaration of Hector Ruiz, Pacific Telephone used an entry control system in its facilities in 1969. Decl. of Hector Ruiz, para 9. The entry control system in question included a standard telephone instrument on the wall at the entrance. Ruiz was provided with a numerical code which he would dial into the entrance telephone via its rotary dial, thereby gaining access to the building. When Ruiz dialed the code into the telephone, the door unlocked directly, permitting him to enter the building directly. Decl. of Ruiz, para. 4.

In his declaration, Ruiz also described another feature of the Pacific Telephone system. According to Ruiz, a set of instructions were posted near the entrance telephone which

advised non-employees who wished to gain entrance to the building to dial a code that was different than Ruiz's direct access code. Upon dialing that code, the visitor was connected to the telephone of an employee within the building. The employee, whose telephone rang in response to the visitor's entry of the code, would answer his or her telephone, establish voice contact with the visitor, and determine the purpose of the visitor's desired admission. If the employee determined that the visitor should be admitted, the employee unlocked the entrance door for the visitor by dialing a certain number on his or her telephone. Ruiz states that he personally operated the system on numerous occasions.

The components of the Pacific Telephone system are described in Hector Ruiz's deposition and declaration. The employee telephones which were selected to receive calls from the entrance, the entrance telephone instrument, and the entrance door latch were connected to a local switching device known as a Key Service Unit (K.S.U.). Decl. of Ruiz, para. 8; Depo. of Ruiz, pg. 27.

In order to limit the number of employee telephones that were callable from the entrance unit, the K.S.U. included a circuit card that would interface between the entrance telephones and the employee telephones that were callable. Depo. of Ruiz pg. 32. The card also connected the callable employees phones with the door strike. Depo. of Ruiz pg. 32; Decl. of Ruiz, para 9.

When an employee's telephone was dialed by the entrance instrument, the instruments were coupled through the K.S.U., thus enabling the employee and the visitor to establish voice contact. If the visitor's entrance was desired, the employee dialed a number on his telephone which would activate the door strike. Decl. of Ruiz para. 9.

Finally, Ruiz states that the Pacific Telephone system was in operation in "dozens of Pacific Telephone facilities in the Los Angeles area alone prior to January 1973. In addition, [Ruiz] personally arranged for the installation of

... such systems for Pacific Telephone customers prior to January 1973. Those customers included the Los Angeles Board of Education, ... Sam & Walter's Camera Repair ... , Greyhound Bus Company, LAX, and a number of airlines." Decl. of Ruiz, para 6.

2. The Difference Between Claim Nine and the Prior Art.

Claim nine of the '641 patent is described in the patent as "[t]he combination of Claim four, wherein said selecting means also addresses a common combination lock device. As interpreted by the Federal Circuit in *Trell v. Marlee Electronics Corp.*, 10 U.S.P.Q. 2d 1790 (1989) (unpublished), claims four and nine of the '641 patent "require only an apparatus that *can be connected* to a door lock and means for *releasing or addressing* a door lock ... Claim 9 depends from claim 4 and, thus incorporates all of the limitations of claim 4. The latter requires a selecting means for dialing telephone numbers to a telephone network ... However, nothing in [claim nine] requires that the public telephone network must be used in addressing a common combination lock device." *Id.*, 10 U.S.P.Q. 2d at 1791.

As this court has already discussed, the *Entraguard* and the *Identiphone* embody each and every element of claim four. The *Entraguard* and the *Identiphone* do not, however, have the direct access feature described in claim nine.

With regard to the Pacific Telephone System, that system does not embody claim four in that it does not use the public subscriber telephone network. However, the same "selecting means" is used to dial both the employees' telephones and activate the mechanism "releasing or addressing" the door lock. In other words, the Pacific Telephone system embodied all of the elements that claim nine added to claim four. This court specifically notes that, under the Federal Circuit opinion in *Marlee*, the use of the public subscriber network is not required by claim nine.



### 3. The Level of Skill in the Pertinent Art.

"In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modifications." *In re Lahu*, 747 F.2d 703, 705 (Fed. Cir. 1984).

In the present case, the defendants, in their moving papers argue that this court should apply the same level of ordinary skill that this court employed in the *Marlee* litigation. In *Marlee*, this court held that a person of ordinary skill in the art in 1973-74 would have a bachelor's degree in electrical engineering, or its equivalent, plus two to five years of practical design experience. The plaintiff has not argued that a different standard should be used. Therefore, this court will employ the same standard that it employed in the *Marlee* litigation.

### 4. Secondary Considerations

The plaintiff presents a number of items which he argues favor a finding of validity. First, the plaintiff presents the letter of the defendant Davis in which he offers to settle the case. Second, Trell presents the licensing agreements between Trell and Bewator Svensk Teleproduktion AB, between Trell and Trigon Electronics, Inc., and between Trell and Doorkey, Inc. The plaintiff also claims that his product has outstanding commercial success.

### 5. Application of the Summary Judgment Standard

"The starting place for determining the issue of obviousness is, as in *In re Winslow* [citation omitted] with 'the inventor working in his shop with the prior art references — which he is presumed to know — hanging on the walls around him'." In addition, the court must also consider secondary considerations. *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 1576 (1984). Of course, "the prior art on the wall consists only of those patents one of ordinary skill in the art would have selected without the

advantage of hindsight or knowledge of the invention. *Id.* This court is mindful of the requirement that hindsight must *not* be used. "Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination." *Uniroyal v. Rudkin-Wiley*, 837 F.2d 1044, 1051 (Fed. Cir. 1988).

However, after considering the evidence that has been presented, this court is of the opinion that a genuine issue of material fact does not remain for trial. Claim nine of the '641 patent is merely the combination of the *Entraguard* and the direct access feature of the Pacific Telephone system or the combination of the *Identiphone* and the direct access feature of the Pacific Telephone system. Using the *Winslow* analogy, this court is convinced that an inventor with the ordinary skill in the art when confronted with the problem of trying to add a direct access feature to the *Entraguard* or the *Identiphone*, would see the obviousness of combining the direct access feature of the Pacific Telephone system with the *Entraguard* or the *Identiphone*. This is especially true in light of the similarity of the Pacific Telephone system to the *Entraguard* and the *Identiphone*.

The plaintiff attempts to show that the combination discussed above is not obvious through the declarations of Edwin Heinlein and Walton Tinsley. In his declaration Heinlein, declares that the aforementioned combination was not obvious to him. The court does not find Heinlein's declaration persuasive. In reviewing his credentials, the only experience set forth is that he is a mathematician and has experience in computer programming and computer security and that he personally used telephone entry control systems in apartment buildings. This court does not find that Heinlein has the requisite ordinary skill in the art. He has put forth no statement of experience in the design of electrical and electrical-mechanical security systems of the type at issue in the present action.

With regard to the declaration of Tinsley, this court does not find his declaration persuasive. Tinsley makes a blanket



statement that the systems presented by the defendants do not render claim nine of the '641 patent obvious. The only evidence presented in the Tinsley declaration bearing on the combination of the *Entraguard* or the *Identiphone* with the Pacific Telephone system is the simple statement that it would not be obvious to one skilled in the art to add a direct access feature to the *Entraguard* or the *Identiphone*. Tinsley does not make any effort to discuss why the possible combination of the *Entraguard* or the *Identiphone* with the Pacific Telephone system was not obvious. Indeed, Tinsley fails to even discuss the combination of those various systems. Tinsley only discusses the various systems presented by the defendants in isolation. The Tinsley declaration therefore fails to point to specific facts which would indicate that a material issue of fact remains for trial because it never addresses the specific combinations of systems put forth by the defendants.

On the other hand, the defendants have presented the declarations of Janess, Ahlstrom, and Leshner that the addition of the Pacific Telephone system's use of the entry-way telephone dial for the entry of both the telephone codes and entrance codes to either the *Entraguard* or the *Identiphone* was obvious in 1972-73. Decl. of Ahlstrom para. 14-16, Decl. of Janess, para. 10-11, Decl. of Leshner, para. 17-18. The plaintiff has not presented any evidence that would contradict these statements. The plaintiff merely attempts to call these statements into question by stating that no one ever actually discussed the modification or thought of the modification. However, the fact that the modification was not thought of or discussed by the declarants is not dispositive. The test is the objective obviousness of the invention. Moreover, the plaintiffs have presented the declaration of Ahlstrom which states that he actually considered a direct access but dismissed it because of the security hazard.<sup>2</sup> Decl. of Ahlstrom, paras. 6, 7, 14.

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<sup>2</sup>Tinsley attempts to buttress the argument in his declaration with the assertion that none of the persons working on the *Entraguard*

The plaintiffs also argue that the combination of the *Entraguard* or the *Identiphone* with the Pacific Telephone system would be an impermissible combination, citing the case of *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1050 (Fed Cir. 1988). However, in *Uniroyal*, the court reversed the trial court's finding of obviousness on the basis that the trial court combined two inventions which employed antithetical properties to render the invention in question obvious. In the present case, the *Entraguard* and the *Identiphone* on one hand and the Pacific Telephone system on the other hand are not antithetical. The court does not find that the combination of the *Entraguard* or the *Identiphone* with the Pacific Telephone system is an impermissible selective combination.

Finally, the plaintiff argues that secondary considerations preclude the granting of summary judgment. A nexus between the merits of the claimed invention and the evidence of secondary considerations is required in order for the evidence to be given substantial significance in an obviousness decision. *Cable Elec. Products, Inc. v. Genmark*, 770 F.2d 1015, 1026 (Fed. Cir. 1985).

In this case, the plaintiff argues that the commercial success of his product shows that the claim nine is not obvious. The plaintiff has put forth no proof of the commercial success of the Trell device. In addition, even if the Trell device is commercially successful, there is no proof that the success is due to the component embodying claim nine. Thus, the plaintiff has failed to show the requisite nexus.

The plaintiff also produces evidence of a license between Trell and Bewator Svensk Teleproduktion. However, that license only applies to European patents. The validity of

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conceived of the combination of a direct access feature and the *Entraguard*. However, this statement overlooks the declaration of Ahlstrom in which he states that he actually considered a direct access feature but dismissed it because of the security hazard. Decl. of Ahlstrom, paras. 6, 7, 14.

any patents in Europe is not affected by a finding of invalidity in the United States as patents are governed by the laws of their respective countries. Again, Trell has not shown the required nexus.

The last two licenses that Trell produces are the Door King and the Trigon licenses. The court does not find these licenses persuasive. First, the evidence is barred by Federal Rule of Civil Procedure 408 since they are the products of settlements. Moreover, even if this court were to admit the evidence, as shown by the deposition presented by the defendants, the Door King license was motivated by the desire to settle litigation. See Depo. of Richmond pp. 58-60. In addition, the Trigon license was based on the erroneous belief that the federal circuit opinion in *Marlee* upheld the validity of claim nine. Depo. of Gagnon, pg. 37. The plaintiff has presented no evidence that would contradict this and has consequently failed to establish the requisite nexus.

For the aforementioned reasons, the defendants' motion for summary judgment is granted as to the invalidity of claim nine of the '641 patent.

IT IS SO ORDERED.

Dated: August 20, 1990

DICKRAN TEVRIZIAN  
DICKRAN TEVRIZIAN  
United States District Judge

I hereby certify that this document was served by hand, to all counsel (or parties) in this action on this date.

Dated: August 20, 1990

MINNA NEUMAIER  
Deputy Clerk

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Attorney for Defendants

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

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ANDERS E. TRELL,  
*Plaintiff and Counterdefendant,*

VS.

SENTEX SYSTEMS, INC., et al.,  
*Defendants and Counterclaimants.*

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CIVIL ACTION NO. 89-3355-DT (Kx)

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**JUDGMENT**

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This action came on for hearing before the Court, Honorable Dickran Tevrizian, District Judge presiding, and the issues having been duly heard and a decision having been duly rendered:

It is Ordered and Adjudged:

On Plaintiff's claim:

That Claim 9 of U.S. Patent 3,947,641 is invalid under Section 103, Title 35 of the United States Code, and that Plaintiff Anders E. Trell recover nothing from the Defendants Sentex Systems, Inc. and Williams R. Davis;

On Defendants' counterclaims:

That Claim 4 of U.S. Patent 3,947,641 is invalid under Title 35, United States Code, Sections 102(a) and/or (b);

That Claim 9 of U.S. Patent 3,947,641 is invalid under Title 35, United States Code, Section 103;

That Defendants' counterclaims directed to Claims 1-3, 5-8, and 10-13 are dismissed without prejudice as moot; and

That Defendants Sentex Systems, Inc. and William R. Davis recover from Plaintiff Anders E. Trell their costs of action.

Dated at Los Angeles, California, this 5th day of October, 1990.

DICKRAN TEVRIZIAN

Honorable Dickran Tevrizian  
U.S. District Court Judge

Presented by:  
Ashen Martin Seldon Lippman &  
Scillieri

ROBERT A. SELDON

Robert A. Seldon  
Attorneys for Defendants

UNITED STATES DISTRICT COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

91-1068

ANDERS E. TRELL,  
*Plaintiff-Appellant,*

VS.

SENTEX SYSTEMS, INC. and WILLIAM R. DAVIS,  
*Defendants-Appellees.*

---

JUDGMENT

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ON APPEAL from the United States District Court for  
the Central District of California in Case No(s). 89-3355.

This CAUSE having been considered, it is ORDERED  
and ADJUDGED:

PER CURIAM (ARCHER, *Circuit Judge*, COWEN, *Senior  
Circuit Judge*, and MAYER, *Circuit Judge*):

*AFFIRMED.* Fed. Cir. R. 36.

ENTERED BY ORDER  
OF THE COURT

Dated: June 7, 1991

FRANCIS X. GINDHART  
Francis X. Gindhart, Clerk

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Note: Pursuant to Fed. Cir. R. 47.8, this disposition is  
not citable as precedent. It is a public record. The disposi-  
tion will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE  
FEDERAL CIRCUIT

91-1068

ANDERS E. TRELL,  
*Plaintiff-Appellant,*

VS.

SENTEX SYSTEMS, INC., and  
WILLIAM R. DAVIS,  
*Defendants-Appellees.*

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ORDER

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**ORDER**

Before ARCHER, Circuit Judge, COWEN, Senior Circuit Judge, and MAYER, Circuit Judge.

A petition for rehearing having been filed in this case, UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby, is denied.

The mandate will issue on July 16, 1991.

FOR THE COURT,

FRANCIS X. GINDHART

Francis X. Gindhart  
Clerk

Dated: July 9, 1991

cc: CHARLES E. WILLS  
ROBERT A. SELDON

TRELL V SENTEX SYS INC, 91-1068  
(DCT — 89-3355)

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Note: Pursuant to Fed. Cir. R. 47.8, this order is not citable as precedent. It is a public record.



MARLEE ELECTRONICS CORPORATION  
400 South Beverly Drive, Beverly Hills, California 90212  
(213) 553-0515

1018

INVOICE NO.

DATE June 5, 1973

STORER ORDER NO.	DATE	OUR ORDER NO.	REF.	SHIPPED VIA	DATE	TERMS
GROSS STAIR	5/15/73	101	Stobla	W/F	6/1/73	15 10, Net 30

BILL TO

SHIPPED (IF O.B. FACTORY) TO

L & L SECURITY PRODUCTS  
928 WEST ANGELENO AVENUE  
BURBANK, CALIFORNIA 91506

SAME

QTY.	S.O.	SHIPPED	MODEL NO OR DESCRIPTION	UNIT PRICE	EXTENSION
3	2	1	1000--SS	\$1,120.00	\$1,120.00
				TOTAL AMOUNT	\$1,120.00

YOU PAY \$ 11.20

BY PAYING THIS INVOICE BEFORE 6/15/73

BEST AVA

Exhibit 1to the License Agreement of September 27, 1983 between  
Bewator and Anders Trel

## Patents granted and applied for:

Sweden	granted	March 2, 1975	No. 373474
U.S.A.	"--"	March 30, 1976	No. 3947641
Canada	"--"	November 2, 1976	No. 999389
England	"--"	May 25, 1977	No. 1474737
West Ger-			
many	"--"	1982	No. 7429959- 2,426,739
France	"--"	1983	No. 7429959
Japan	patent applied for		No. 64 156/74

Alarm control

Swedish patent application No. 8201162-8 was submitted on February 24, 1982 and PCT application was submitted in August 1983.

Patent attorney: Swedpatent Stockholm  
Tel. 08-32 61 41

"--" STU  
Engineer Timl Fagerholm  
Tel. 08-744 51 00

Estimated patent expenses

<u>Entry phone</u>	<u>Annual fees in Sw. Kr.</u>				
Country	1983	1984	1985	1986	1987
Sweden	1,510	1,510	1,810	1,810	2,210
England	Paid	2,050	2,300	2,500	2,700
West Germany	2,460	3,060	3,885	4,600	5,350
France	Paid	1,250	1,380	1,610	1,650

Alarm control

No expenses in 1983, but in 1984 there will be a printing cost of approximately 1,140 Sw. Kr. On January 1, 1985 there will be expenses of Sw. Kr. 8,000—12,000 per country for completion of the PCT application.